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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/625,716

07/23/2003

Stacie Linsky

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10/07/2010

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EXAMINER

HALE, GLORIA M

ART UNIT

PAPER NUMBER

3765

MAIL DATE

DELIVERY MODE

10/07/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/625,716	Applicant(s) LINSKY ET AL.	
	Examiner Gloria Hale	Art Unit 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12-10-09 *Board Decision*.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In view of the Board of Appeals Decision filed on 12-8-2009, PROSECUTION IS HEREBY REOPENED. A new Non-Final Office Action is set forth below.

A Technology Center Director has approved of reopening prosecution by signing below:

/KAREN M. YOUNG/

Director, Technology Center 3700

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 8 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clifford (US 4,735,572) in view of Fingelson (US 5,479,661).

Clifford discloses form-fitting illustrated garment 10 (a body leotard or the like, which covers the arms, legs and torso areas; see Clifford, col. 1, lines 46-49). The Clifford garment includes illustrated markings/indicia/printed matter (11-17), that represents joint functioning areas and the structure of a wearer's shoulders, elbows, wrists, hips, knees and ankles. (See Clifford, col. 2, lines 59-67). The illustrations on the garment allow for instruction and body manipulation methods and movement as

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desired by a body manipulator, instructor and the wearer. (See Clifford, col. 3, lines 13-35). Clifford also discloses the garment as having instructions thereon to manipulate the body (See col. 6, lines 30-35).

Clifford also discloses the garment as being a “close fitting garment” which is considered to be a “form-fitting garment” as broadly claimed. (See Clifford, col. 7, line 10; col. 8, lines 11 and col. 6, line 57).

Applicant’s original specification did not provide a specific definition for the term “form fitting”. Applicant’s specification in the “summary of the Invention” and in the “Detailed Description” indicate that a garment that holds the breasts in a relative stationary and flattened or compressed position is a preferred embodiment of the invention. A “Non-preferred embodiment” of the invention, and therefore, the general term of “form-fitting”, does not require that the breast be held in a relatively stationary flattened or compressed position. Applicant’s specification also did not include a specific definition for a “shirt” or “t-shirt”. Additionally, The Board of Appeal’s decision of 12-8-2009 has affirmed that the Fingelson garment is considered to be a shirt or t-shirt that is formfitting.

Accordingly, it would have been obvious at the time the invention was made to modify the Clifford garment to provide the garment in a shirt embodiment to be worn with other lower torso, short or pant garments instead of a one piece bodysuit for increased comfort to the wearer in a warmer environment, and for greater ease in donning and doffing the garment. It is well known that t-shirts and shirts with indicia thereon are widely available in the marketplace and that the shirts often include

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instructional indicia thereon. Therefore including the indicia of the Clifford, Fingelson or any other sets of instructional indicia on a shirt or t-shirt, would have been an obvious modification of such t-shirts or shirts in order to provide the desired instructional applications on such well used garments as desired.

Clifford discloses the garment as being able to "provide a garment in the form of a body leotard with markings appropriate to specifically selected applications".

Clifford's garment covers a wearer's entire body from their neckline to their ankles including the arms, underarm area and armpit area. Clifford's selected application is for dance movement instruction and not for breast examination.

However, Clifford does not include the instructional printed matter of breast examination instructions.

Fingelson discloses "an upper body torso garment (10) having open sides with ties, with a front panel that includes printed written and graphic instructions for breast self-examination (38,40) as seen in col. 3, lines 35-67; col. 4, line 10 and col. 2, lines 2-6). The Fingelson garment is formed of a thin material as broadly claimed. (See Fingelson, col. 3, lines 1-4). The Fingelson garment comprises a low-coefficient of friction since it allows the movement of the hands on the surface of the garment about the breasts with the examination pattern disposed on the garment so that it overlies a breast of the wearer as claimed in claims 3 and 4. (See Fingelson, col. 3, line 35- col. 4, line 23). The material of Clifford and Fingelson et al is of the same frictional coefficient since they are all constructed of general garment, leotard and shirt fabrics

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widely used in the marketplace that allow for hand movement there across the fabric's surface.

The Fingelson garment comprises at least one alignment mark 42 centrally disposed with the examination pattern to center a wearer's nipple as claimed in claim 5. (See Fingelson, col. 3, line 42). Fingelson et al discloses the pattern designs as claimed in claim 8 as seen in the Fingelson et al figures.

Fingelson discloses the method of breast self-examination as in claim 28, including obtaining the breast examination pattern 10 thereon 38, 40, putting on the garment, aligning the garment pattern with the breast, and examining the breast as claimed. (See Fingelson, col. 4, lines 10-23 and figures 1, and 3-8). The wearer of the Fingelson et al garment would palpitate the breast "from the outside of the garment" wherein the term "outside of the garment" is broadly considered to be away from the garment material layer or outside of the garment material and not sliding or gliding over the garment material "surface" as intended by applicant.

Clifford discloses a method of placing a form fitting garment that is closed about the body including instructional printed matter. When the instructions for breast examination are included on a closed torso garment as in Clifford, the closed structure would not allow for the examination to be completed inside of the garment surface and the examination would have had to have been done on the outer surface of the garment. One of ordinary skill in the art would have also included the steps of running the hands over the garment surface and breast examination indicia when the garment is closed for reasons of modesty. Some wearer's would not want to wear an open garment

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and perform the exam as stated in Fingelson's and would want to perform the exam with a closed garment as disclosed by Clifford following the guidelines for the exam on the top of the fabric surface especially when other's are present such as a breast examination instructor. Additionally, the Fingelson et al garment is also capable of being used from the outside surface of the garment and nothing would prevent a wearer from utilizing the printed instructions for examination of the breasts on the outside surface of the Fingelson et al garment. Therefore, after modifying the Clifford closed garment with the instructional elements of the Fingelson et al garment thereon, it would have been obvious to perform the examination on the closed Clifford garment on the outer surface of the garment since one would not be able to enter underneath the garment to perform the exam on the skin surface of the wearer. One of ordinary skill in the art would have had the skill and knowledge to place the breast examination indicia on any type of upper torso garment, and to perform the examination on the outer surface of those garments if the garment was not loose enough to place one's hands thereunder. Furthermore, the Clifford and Fingelson garments are both instructional garments and are therefore considered analogous art.

Claims 7, 11-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clifford (US 4,735,572) in view of Fingelson et al (US 5,479,661) as applied to claims 1-5,8 and 28 above, and further in view of Morrison (US 4,873,982).

In regard to claim 7, Clifford and Fingelson disclose the invention substantially as claimed. The Clifford garment extends over the underarm area of the wearer. The Clifford garment has printed instructional information at each body joint including the shoulders, wrist and elbow. However, it does not include instructional indicia at the armpit area. The Morrison garment is a breast examination garment that extends to an underarm or side area of the wearer. The Morrison garment is also constructed of a material with the desired coefficient of friction needed for each examination done across the wearer's skin, in addition to under arm area in the tube top structure of the garment. Morrison also discloses that the garment is adapted for use in other area of the body where the detection of lumps is desired (such as the underarm areas). (See Morrison, col. 4, lines 18-17). Also, it is disclosed by Morrison that a doctor may mark the garment. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the Clifford and Fingelson garment to extend under the arm areas by including the side portions as seen in Morrison, and to mark those areas in a similar fashion as the Fingleson front surface (as suggested by Morrison in col. 4, lines 12-17) in order to effectively examine the wearer for breast cancer. The Clifford, Fingelson et al and Morrison garments all have the desired coefficient of friction as claimed in claims 12 and 13. The coefficient of friction claimed is only so that one may glide their hand or finger there over the garment. No specific coefficient of friction numbers, measurement or figures have been claimed or disclosed. Only a "low coefficient of friction" to facilitate hand and figure movement" is disclosed. "Low" is a relative term and Applicant's original specification and claims has not provided an

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indication as to what the coefficient of friction is, as to what a "low" coefficient of friction encompasses or as to what the coefficient of friction is "low" in respect to. Also, applicant has not described as to what "hand and finger movement are being facilitated" encompasses.

The Examiner interpreted such movement as being that one can slide or glide their hand or fingers over the material of which the Clifford, Fingelson et al and Morrison materials all are capable of allowing.

Applicant's claimed materials are well known garment or shirt materials all of which allow the easy movement across the fabric surface with one's hands or fingers.

Additionally, one of ordinary skill in the art at the time the invention was made would have had the skill and knowledge to include the indicia in the armpit and underarm areas of the garment that lie over those same armpit and underarm body areas of a wearer. It is well known in breast examination instructional printed matter to include indicia that instruct breast examination in the underarm and armpit areas of a wearer since it is well known that the breasts, especially of large breasted women, extend to the underarm or side areas of a woman's body. Additionally this area includes the lymph glands that are also affected by cancer and which also extend to those areas which need to be examined in a breast examination.

Claims 9, 10, 19-23,25-27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clifford (US 4,735,572) in view of Fingelson et al (US 5,479,661) as applied to claims 1-5, 8 and 28 above, and further in view of Rusin (US 6,412,491)

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Clifford and Fingelson et al discloses the invention substantially claimed.

However, Fingelson does not specifically disclose the marker pens as claimed.

Rusin discloses a breast examination device with a sheet material and a marker pen 150, col. 3, lines 28-34, in order to mark areas on the sheet 101 for further examination or area of concern. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the garment of Clifford and Fingelson et al with a marking pen to mark areas on the garment over the site on the wearer where further examination or areas of interest are on the wearer.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clifford in view of Fingelson et al and Morrison (US 4,873,982) as applied to above, and further in view of Rusin (US 6,412,491).

Clifford and Fingelson et al disclose the invention substantially as claimed. However, they do not specifically disclose the marking indicators as claimed. Rusin discloses a marking pen in col. 3, lines 32-34 that is used to mark areas of interest or areas for further examination on the sheet material covering the wearer or patient. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the garment of Fingelson and Morrison to include a marking pen as disclosed by Rusin in order to mark areas on the garment over the sites where further examination or areas of interest are on the wearer.

Allowable Subject Matter

Claims 6, 15 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in dependent form including all of the limitations of the base claims and any intervening claims.

None of the cited references, alone or in combination, disclose the nipple aperture for nipple location on the garment as claimed in claims 6, 15 and 24.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria Hale whose telephone number is 571-272-4984. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on 571-272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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